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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LAstra, DANIEL

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/964,600	<b>Applicant(s)</b> KAWAHARA ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/04/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 14, 16, 19 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 14, 16, 19 and 37-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1, 14, 16, 19, 37-47 have been examined. Application 09/964,600 (PORTABLE TERMINAL DEVICE FOR PROVIDING AND OBTAINING ADVERTISEMENT INFORMATION, ADVERTISEMENT PROVIDING METHOD, ADVERTISEMENT OBTAINING METHOD, ADVERTISEMENT DISTRIBUTING METHOD AND PROGRAM THEREFOR) has a filing date 09/28/2001 and foreign priority 06/04/2001.

### **Response to Amendment**

2. In response to Non Final Rejection filed 09/04/2008, the Applicant filed an Amendment on 03/04/2009, which amended claims 1, 14, 37, cancel claims 26, 28, 29, 33-34 and added new claims 38-47.

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 is indefinite because presents a problem of antecedent basis with the limitation "said user information".

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14, 16, 19, 37-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Pradhan (US 2002/0160759).

As per claims 1 and 14, Pradhan teaches:

An advertisement distributing method of a server providing advertising information, comprising:

receiving user-specified information about an advertisement medium person having goods on or with him or her and a retrieval condition of the goods which the advertisement medium person has on or has with him or her from a portable terminal device of a consumer, by the server through a network (see paragraphs 105-106, and 120);

specifying by the server an advertisement medium person corresponding to the received user-specified information among user specified information of a plurality of advertisement medium persons stored in a storage device, and retrieving advertising information of goods corresponding to the retrieval condition received from the portable device from advertising information of a plurality of goods stored in the storage device which the specified advertisement medium person has on or has with him or (see paragraphs 105-106, 120); and

distributing the advertising information obtained by said retrieving from the server to the portable terminal device of the consumer via the network (see paragraph 48);

As per claim 16, Pradhan teaches:

The advertisement distributing method of claim 1, comprising:

receiving a user entry of the person having the goods on or with (see paragraph 99) and

distributing the advertising information about the goods obtained by said retrieving to a portable terminal device of person (see paragraph 99), and

requesting transmission of the advertising information or transmitting the advertising information between the portable terminal device of the person and the portable terminal device of the consumer (see figure 1).

As per claim 19, Pradhan teaches:

The method according to claim 1, wherein said user information comprises user-specified information, information designating whether or not an advertisement can be distributed, a term of distribution, and information designating access destination for advertising information (see paragraph 7).

As per claim 37, Pradhan teaches:

A method of providing advertisement, comprising:

storing a predetermined advertisement on a portable terminal of a first user, said predetermined advertisement corresponding to a product that the first user has on or with him or her, being transmitted from a provider of the product and identifying the product (see paragraph 106);

receiving user-specified information of the first user and a retrieval condition from a device of a second user (see paragraph 120); and

retrieving said advertisement corresponding to the received retrieval condition from the portable terminal of the first user responsive to receipt of the user-specified information and said retrieval condition from the second user (see paragraph 120)

transmitting the retrieved advertisement to the device of the second user, thereby enabling the first user to provide said advertisement corresponding to the product which the first user has on or with him or her on behalf of the provider of the product (see paragraphs 105-106) and

displaying the advertisement received from the portable terminal of the first user on a display screen of the device of the second user (see paragraph 34).

Claim 38, Pradhan teaches:

when storing the predetermined advertisement on the portable terminal (see paragraph 106);

transmitting information identifying goods that the first user has purchased, and user-specified information of the first user to the provider (see paragraph 120); receiving an advertisement corresponding to the goods corresponding to the transmitted identifying information from the provider and storing the received advertisement on the portable terminal (see paragraph 120).

Claim 39, Pradhan teaches:

An advertising information delivery method for delivering advertising information corresponding to goods, the method comprising:

sending a request for advertising information from a consumer terminal device to an advertising person terminal device, the advertising person terminal device storing advertising information corresponding to goods that the advertising person carries or possesses (See paragraph 106);

sending the requested advertising information from the advertising person terminal device to the consumer terminal device (see paragraph 106); and displaying the advertising information received from the advertising person terminal device on a display unit of the consumer terminal device (see paragraph 106).

Claim 40, Pradhan teaches:

An advertising information distributing method for delivering advertising information for advertising goods, the method comprising:

transmitting a request for advertisement information corresponding to certain goods from a first terminal device to a server device, with information identifying the certain goods that a person having the first device has purchased (see paragraph 120); receiving advertising information corresponding to the certain goods from a server device (see paragraph 120);

storing the received advertising information in a storage device within the first terminal device and transmitting the stored advertising information to a second terminal device when the first terminal device receives a request for advertising information corresponding to the certain goods from the second terminal device (see paragraph 120).

Claim 41, Pradhan teaches:

transmitting information for identifying the first terminal device or the person having the first terminal device to the second terminal device when the first terminal device receives the request from the second terminal device (see paragraph 120).

Claim 42, Pradhan teaches:

A portable terminal device, comprising:

a storage unit that stores advertisement information corresponding to goods which an owner of the portable terminal device has on or with him or her, or has purchased; a communication unit that communicates with another device (see paragraphs 105-106); and a control unit; wherein, when the communication unit received a request for advertisement information corresponding to the goods from the other device, the control unit retrieves the storage unit and obtains advertisement information corresponding to the goods that have been requested, and the communication unit transmits the obtained advertisement information to another device that has sent the request (see paragraph 120).

Claim 43, Pradhan teaches:

an input unit for inputting information (see paragraph 120); wherein the communication unit transmits a request for advertisement information corresponding to certain goods with goods information inputted from the input unit, the goods information identifying the certain goods in which the owner has purchased, and the control unit stores received advertisement information into the storage unit (see paragraph 120).

Claim 44, Pradhan teaches:



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A server device comprising: a communication unit that communicates with the other devices; a storage unit that stores advertisement information for advertising certain goods, and customer information for identifying a customer that has purchased the certain goods or has the certain goods on or with him or her (see paragraphs 105-106); and a control unit; wherein, when the communication unit receives a request for advertisement information with customer information from another device, the control unit retrieves the storage unit and determines advertisement information corresponding to the received customer information (see paragraph 120), and the communication unit transmits the determined advertisement information to another device that has sent the request (see paragraph 120).

Claim 45, Pradhan teaches:

wherein when the received request contains a retrieval condition, the control unit retrieves the storage unit and determines advertisement information that meets the received retrieval condition (see paragraph 120).

Claim 46, Pradhan teaches:

wherein the communication unit receives a request asking for advertisement information corresponding to certain goods from another device, the request including customer information for identifying a customer and goods information for identifying goods which the customer has with him or her or has purchased (see paragraphs 105-106),

the control unit relates the received customer information and the goods information, and stores the related information into the storage device, and

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the communication unit transmits advertisement information corresponding to the requested goods to the other device that has sent the request (see paragraph 120).

Claim 47, Pradhan teaches:

A method of providing advertisement, comprising:  
storing information of an advertisement on a portable terminal of a first user, said information being provided to the first user from a provider advertising a product (see paragraph 35);

retrieving said advertisement based on a condition from the portable terminal of the first user and transmitting the advertisement to a device of a second user that is independent of the provider and the first user (see paragraph 7); and  
displaying the advertisement received from the portable terminal of the first user on a display screen of the device of the second user, thereby enabling the first user to provide said advertisement on behalf of the provider of the product (see paragraph 34).

### ***Response to Arguments***

5. Applicant's arguments filed 03/04/2009 have been fully considered but they are not persuasive. The Applicant argues that Pradhan does not teach storing in a portable device, advertisement information about the goods that the user of the portable device has on or with him or her. The Examiner answers that Pradhan teaches companies agree to contribute to a mobile telephone bill if the mobile telephone (i.e. portable device) carries their advertisement (i.e. goods that the user of the portable device has on or with him or her) and broadcasts it (see paragraph 106). Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed invention.

The Applicant argues that Pradhan does not teach “receiving user specified information about an advertisement medium person”. The Examiner answers that Pradhan teaches a system where an advertiser portable terminal (i.e. advertisement medium person) transmits advertisement information to a consumer portable terminal, where said consumer portable terminal request additional information related to said advertisement from a remote server via a network and where said request includes an advertiser portable terminal identification (i.e. user specified information about an advertisement medium person”) (see paragraph 120). Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed invention.

The Applicant argues that Pradhan does not teach “a first user with a product that the first user has on or with him or her, transmitting the retrieved advertisement to the device of the second user and displaying the advertisement received from the portable terminal of the first user on a display screen of the device of the second user”. The Examiner answers that Pradhan teaches transmitting advertisement information from a first user (i.e. advertiser portable terminal) to a second user (i.e. consumer portable terminal) (see paragraph 15) and displaying said advertisement in a display screen of said second user adapted to display the advertisement (see paragraph 34). Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed invention.

The Applicant argues that Pradhan does not teach “a first user” “a provider advertising a product” and “retrieving said advertisement based on a condition from the portable terminal of the first user and transmitting the advertisement to a device of a

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second user that is independent of the provider and the first user". The Examiner answers that Pradhan teaches that "a company (i.e. a provider advertising a product) may agree to contribute to a mobile telephone bill if the mobile telephone (i.e. first user) carries their advertisement and broadcast it" to a second user (see paragraph 106), where the second user (i.e. consumer portable terminal) is a different entity (i.e. independent) of the provider and first user (i.e. advertiser portable terminal). Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed invention.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
June 9, 2009